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**JUN 14 2005**

**OFFICE OF PETITIONS**

In re Application of	:	
Spielberg	:	DECISION
Application No. 09/928,392	:	
Filing Date: 13 August, 2001	:	
Attorney Docket No. 15343-0028C3	:	

This is a decision on the renewed petition filed on 31 May , , 2005, alleging, *inter alia*, unavoidable delay under 37 C.F.R. §1.137(a), alternatively requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181, and alleging unintentional delay under 37 C.F.R. §1.137(b).

For the reasons set forth below:

- the petition under 37 C.F.R. §1.137(a) is **GRANTED**;
- the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**; and
- the petition under 37 C.F.R. §1.137(b) is **DISMISSED as moot**.

**BACKGROUND**

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 19

March, 2004,<sup>1</sup> with reply due absent extension of time on or before Monday, 21 June, 2004;

- the instant application went abandoned after midnight 19 June, 2004;
- the Office mailed a Notice of Abandonment on 2 December, 2004;
- with the original petition (with fee authorization), Petitioner failed to submit the required reply (election) and alleged non-receipt but did not evidence non-receipt (and that the materials were not mis-docketed), and for those reasons the petition was dismissed on 28 February, 2005;
- the instant petitions were filed on 31 May, 2005, with fee authorizations and an amendment as the reply.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>3</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing

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<sup>1</sup> A copy of this paper is enclosed with this decision.

<sup>2</sup> 35 U.S.C. §133 provides:  
**35 U.S.C. §133 Time for prosecuting application.**  
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup> And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>))

Petitioner requests withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>8</sup>

While Petitioner made a showing that the Office action was not docketed to the instant application by Petitioner's office, Petitioner made no showing that the Office action was not mis-docketed by his office, and so failed to satisfy the "showing" burden as discussed above.

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and--where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

Petitioner has satisfied the requirements as to a petition under 37 C.F.R. §1.137(a).

### CONCLUSION

The petition:

- under 37 C.F.R. §1.137(a) hereby is **granted**;
- as considered under 37 C.F.R. §1.181 is **dismissed**; and
- under 37 C.F.R. §1.137(a) is **dismissed as moot**.

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<sup>5</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>8</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to be 'J. Gillon', written over the printed name.

John J. Gillon, Jr.  
Senior Attorney  
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